



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/977,644      11/24/97      EMERSON      R      PROG.003.00U

RAE VENTER LAW GROUP  
P O BOX 60039  
PALO ALTO CA 94306-0039

HM12/1127

EXAMINER

LEVY, N

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

11/27/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

08

Application No.

977644

Applicant(s)

LEMERON, JR

Examiner

NOEL

Group Art Unit

16/6

10

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

11/1/99

- ☒ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-17 is/are pending in the application.
- Of the above claim(s) 17 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-16 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☒ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1616

Receipt is acknowledged of Supplemental response of 11/1/99.

Applicant asserts there is no attempt to enlarge the scope of the claims of the original patent (item 2, of Reissue Declaration), and in fact, states claims are overly broad (item 3).

The amendments to claims 1, 5, 8, 19, 14 enhance clarity, as do the amendments to the specification. No question of patentability is raised by these amendments. The negative amendment to claim 7 does result in a narrower claim. However, there is no basis for this negative limitation in the specification. Cinnamic aldehyde is applicant's preferred compound. The acceptable limitation means is to specify the desired compound, supported in the specification, in consisting of format, to exclude cinnamic aldehyde. However the limitations of claim 17 are broader than original patent claims, as they now no longer have to be suitable for use as a bait, or for anything else. As to the basis for this claim in the original application, applicant can not recapture.

Claim 17, and the "or 17" of ~~2~~ 15, 16, should be canceled.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1616

Claims 7, and 12-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims are to (7) an excluded species not so supported in the specification; applicants is attempting to exclude the preferred compound-instead, identify desired compounds in "consisting of" format.

Claims 1, 2, 5-8, 12-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not contain enough exemplary matter to support broad term: "an organic substituent containing from 1 to 10 carbon atoms (each occurrence). Only specific compounds, not the generic formulae have been shown effective to meet the claim language, and only for specific concentrations, formulation, application methods, and pests. These should clearly be claimed in order for one in the art to be able to practice this invention without undue experimentation.

Claims 1-7, 13, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1616

There is no "said insect-" in claim 1 preamble. Claim 5 does not further limit claim 1. Claim 7 is indefinite as to applicant's intended use of "associated with" and "solid" Examiner fails to see any difference between claims 15 and 16.

Claims 7, 12-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The exclusion of cinnamic aldehyde, and antioxidant, are not supported in the specification.

Claims 1-6, 15, 16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims are beyond the scope of the specification, no results of exposure to cinnamic or cinnamyl aldehyde, the only tested compounds, at 10-2000 ppm, is shown, there is no assurance of efficacy as claimed, there are no explanation of how the cinnamic aldehyde, dissolved in water, can be effective - the compound is water insoluble. Neither are baits shown - there is no enabling disclosure showing capability of attraction, to a housing, of a cinnamic or other aldehyde on a solid support, methods for cockroaches are shown to require direct contact, thus, should be so claimed.

Claims 7, 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Howell et al. 5102675.

Art Unit: 1616

Cinnamaldehyde is shown in an aqueous composition, associated with a solid support, of cellulose, (Oak - col. 2, lines 32-37), in containers (col. 8).

No patentable weight is given to the future intended use.

Claims 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Armstrong 5149715 or Brekhman et al. 4808574.

*Re Armstrong*: Instant aldehydes (col. 3), cinnamic, are applied to crop substrate at 1-200 ppm or higher (col. 3, top) as an emulsion with detergent Tween 80 (lines 49-65) with or without antioxidants (col. 5, top) Example 1 shows 1000 ppm cinnamon oil (90% cinnamaldehyde - col. 5, lines 22-24). This is within the range of the instant concentrations disclosed as providing 70% or greater kill. No patentable weight is given to future intended use of the composition - these are inherent properties.

Brekhamn: The instant flavonoid and aromatic aldehydes at the concentration as shown to effect the claimed control is shown; thus, as above, the instant composition (see Col. 2, 3).

Claims 1-5, 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyazaki et al. JP 01261303.

Cinnamic aldehyde (p. 3), with carrier, (p. 4, 5) in detergent compositions, with or without antioxidants, at 0.1-30% (p. 6), application on solid support or as liquid, if desired, placed in a chamber into which thrips can be entered or removed (p. 7, fig. 1) and provides potent control - death of 82% (p. 8, table).

Art Unit: 1616

Claims 1-6, 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ando - JP 266809.

See Cockroach repellent effectiveness test - 94% die (table 2) when <sup>cinammic</sup> aldehyde compositions see "means of solving-problems" are applied to a solid surface and floor of a box into and out of which cockroaches go. Non-cinnamic aldehyde compounds were tested - they were less effective (hinoki).

Claims 1, 3, 5, 7, 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Metcalf et al. '89.

100 mg in 1 liter cartons, of either cinnamic aldehyde, or a methoxy analog (an organic 1 c containing substituent), without antioxidant, controlled diabrotica (p. 1621). The solid support was the cotton dental with (cellulose) attached to paper (cellulose) - many associations - with cellulose binding domains - the traps provide for egress and ingress.

Claims 1-5, 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Saotome - FR 2529755.

5-50% concentrates of the instant invention, as detergent compositions are presented - thus, would meet the composition requirements, inherently (p. 2, 3 translation) 100% kill resulted from only 100 ppm (Example 5, p.18) - Clearly the concentrate would also kill 100%, had it been needed.

Claims 1-5, 7-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Dorman et al. - 2465854.

Art Unit: 1616

1-25% sprays of cinnamic aldehyde, absent anti oxidants, are applied to kill over 77% insects (flies, table), other of the instant compounds, free of cinnamic aldehyde (ie - amyl, table), Associated with solid supports - powders (col. 2, 3-cellulosic) are contemplated, as are detergent compositions (claim 2).

Claims 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Lintz - 450370 or Rambaut - 74940 or HEISLER 75161.

Lintz provides a soap (carbolic based) deodorizer composition of cinnamic aldehyde - a major component of oil of cinnamon - at levels clearly able to kill 70% insects - No patentable weight given to future intended use or inherent effects so does Rambaut, but at lower levels; . 7 g/l, who provides cinnamic and style sidings; sources of cinnamaldehyde and comfrey aldehyde.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heisler in view of Artander.

Heisler (above) provides cinnamic aldehyde compositions, oral. But the composition is a bitters. Artander show confer aldehyde a known maple syrup component providing sweet - balsamic, Maple - like interesting flavorant/odorant.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made desiring to utilize Heislars composition and motivated to provide acceptable application, to add comfrey aldehyde in order to obtain sweet, maple like interesting flavor.

Claims 1-5, 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Turney - 52345.



Art Unit: 1616

Turney shows insect control with cinnamic aldehyde - a known ingredient of cassia (quassia), with in the instant concentration, this providing instant effects.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 54, 56-62 of copending Application No. 08/479623. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are obvious over the application methods of 07/479623, since the same compounds are applied at the same rate with the same effect.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5676958. Although the

Art Unit: 1616

conflicting claims are not identical, they are not patentably distinct from each other because the patent encompasses the application.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-7, 12, 13, 14, 15 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-8 of prior U.S. Patent No. 5676958. This is a double patenting rejection.

Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 5792467. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant composition is claimed, no patentable weight given to further intended use but it is associated with solid supports - polymers, skin, storage containers.

Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8, 25, 29-39, 41, 57-61, 66-69, 71-75, 77-86 of copending Application No. 08/860,514. Although the conflicting claims are

Art Unit: 1616

not identical, they are not patentably distinct from each other because encompasses the instant invention as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 14-16, 29-33 of copending Application No. 08/860499. Although the conflicting claims are not identical, they are not patentably distinct from each other because encompasses the instant invention as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-5, 7-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 8, 10, 14-23, 29, are of copending Application No. 08/366973. Although the conflicting claims are not identical, they are not patentably distinct from each other because 366973 encompasses the instant invention as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-6 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5-10, 12-14, 16, 17, 19-22 are of copending Application No. 09/431542. Although the conflicting claims are not identical, they

Art Unit: 1616

are not patentably distinct from each other because 431542 encompasses the instant invention as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308-2412. The examiner can normally be reached on Tuesday through Friday from 7:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-2468. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

N. Levy:jmr

November 15, 2000

  
NEIL S. LEVY  
PRIMARY EXAMINER